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JAW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Avner SPECTOR

Serial No.: 10/617,037

Filed: July 11, 2003

For: **PRESSURE-PULSE THERAPY
APPARATUS**

Examiner: Ruth S. Smith

[illegible]

Group Art Unit: 3737

Attorney Docket 26141

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION/PETITION UNDER 37 CFR 1.182

Sir,

This is a Request for Reconsideration of the refusal by the Examiner, in the Advisory Action of December 29, 2006, to enter a proposed amendment to Claim 27; or in the alternative, a Petition under 37 CFR 1.182 to overrule the Examiner and to enter the proposed amendment.

Following are the reasons for this Request for Reconsideration/Petition.

Background:

1. This patent application was filed July 11, 2003 as a Division US Patent Application No. 09/814,359 filed March 22, 2001, which is a continuation-in-part of PCT/IL00/00069, filed February 3, 2000. A Final Action issued on this case on January 30, 2006; and in response, Applicant filed on May 30, 2006 a Request for Continued Examination, including a new set of Claims 27–46.

2. An Official Action was issued on August 3, 2006, in which the Examiner: (a) objected to Claims 27–46 because of an informality in Claim 27 from which the remaining claims depended; (b) rejected Claims 27–46 under 35 U.S.C. 112, First Paragraph, on the ground that Claim 27 only appeared to read on the embodiment of Fig. 7; and (c) rejected Claims 27–46 under 35 U.S.C. 112, Second Paragraph, in which the Examiner raised a question as to the language used in Claim 27.

3. An amendment was filed on September 8, 2006, in which Claim 27 was amended in a manner to avoid the objection and rejections of the Office Action of August 3, 2006.

The Final Rejection of November 20, 2006

4. In response to the Amendment filed on September 8, 2006, a Final Rejection issued on November 20, 2006 in which the Examiner made only the following objections and rejections:

(a) Claims 27–46 were objected to because Claim 27 (from which all the other claims depended) lacked an antecedent for “said closed end” recited in line 6; and

(b) Claims 33–34 and 36–43 were rejected under 35 U.S.C. 112, First and Second Paragraphs. With respect to the First Paragraph, the Examiner commented “It should be

noted that Claim 27 only appears to read on the embodiment of Fig. 7 in that only Fig. 7 shows an acoustical coupling member positioned within the enclosure". With respect to the Second Paragraph, the Examiner noted "The structure set forth in Claims 33–34, 36–43 is not consistent with an acoustic coupling member within the enclosure.

5. The Final Action of November 20, 2006 included no rejection based on prior art; rather, the Examiner stated: "Claims 27–32, 35, 44–46 would be allowable if rewritten or amended to overcome the objections set forth in this Office Action".

The Proposed Amendment Refused Entry

6. The proposed amendment refused entry was filed December 11, 2006. It amended only Claim 27 in the following two respects:

(a) First, it changed "closed end" – – open end – – . The accompanying Remarks pointed out that "closed end" was clearly and obviously merely a typographical error which was corrected by the Amendment.

(b) Claim 27 was further amended to delete the words "within said enclosure and". The accompanying Remarks also pointed out that this amendment was to correct what was also clearly and obviously an error since it was clear that Claim 27, the only independent claim, was intended to be generic to all the disclosed embodiments, and not to be restricted to only the embodiment of Fig. 7.

The Proposed Amendment Does Not Raise New Issues

7. It is clear that the proposed Amendment, whose entry was refused by the Examiner, does not raise new issues by the applicant, but rather merely corrects informalities correctly noted by the Examiner in the Final Action. In other words, if any "issues" were raised by the proposed amendment, they were not "raised" by the

Applicant, but rather were “raised” by the Examiner in the Final Action. All that Applicant did was to correct clear and obvious informalities noted by the Examiner in the Final Action.

8. The Examiner’s justification for the refusal to enter the amendments to Claim 27 is that “The proposed changes to Claim 27 broaden the claim and therefore raises new issues.”

9. While deleting any recitation in a claim may be considered as “broadening the claim”, in this case the amendment to Claim 27 certainly did not “raise new issues”. Thus, there was no issue as to the relevancy of the prior art, since there was no prior art relied upon in the rejection in the Final Action. Accordingly, any prior art not considered relevant to Claim 27 before the amendment which included a particular recitation, it could hardly be considered relevant to the claim after the amendment cancelling that recitation even if the claim was broadened by such a cancellation. In other words, prior art not considered relevant with respect to a restricted claim could hardly be considered relevant when that recitation is broadened.

10. What is particularly ironic in the Examiner’s refusal to enter this amendment is that the Final Action by the Examiner implicitly “invited” the Applicant to amend Claim 27 in order to overcome the objections set forth in that Action, since the Examiner expressly states that the claims would be allowable “if rewritten or amended to overcome the objections set forth in this Office Action”.

11. The Applicant will readily agree that, in many cases, amendments proposed after a Final could very well raise new issues, and therefore the Examiner, in the Examiner’s discretion, could refuse entry of such amendments on the grounds that

they would raise new issues. Actually, that is why the Applicant, when filing a new set of claims after the first Final Rejection, specifically filed the new set of claims with a Request for Continued Examination, and paid the appropriate fee therefor. However, this is clearly not such a case. In this case, the proposed amendment merely corrects obvious errors noted by the Examiner in the Final Action, and makes no amendments which would raise new issues or require an additional search, and therefore the Examiner's refusal to enter the amendment constitutes a clear case of abuse of discretion.

12. For the foregoing reasons, it is respectfully requested that the proposed amendments be entered as placing the application in condition for allowance, or at least for purposes of appeal.

13. An early Decision is particularly solicited since the deadline for filing the Notice of Appeal is February 20, 2007.

It is not believed that any official fee is required by this Request for Reconsideration/Petition, but if such a fee is necessary, please charge same to our Deposit Account 50-1407.

Respectfully submitted,



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January 16, 2007